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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/636,781	08/11/2000	Axel Burmeister	Beiersdorf 630-	8467

7590 10/03/2003

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EXAMINER

LEE, RIP A

ART UNIT PAPER NUMBER

1713

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/636,781

Applicant(s)

BURMEISTER ET AL.

Examiner

Rip A. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on August 21, 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 5-11 is/are pending in the application.
- 4a) Of the above claim(s) 8-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-3 and 5-11 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

This office action follows a response filed on August 21, 2003. Entry of amended claim 1 was requested. Specifically, the parent claim includes the limitation of containing a mixture of blocking-agent free isocyanates. Claims 4 and 11 were canceled.

Claims 1-3 and 5-7 remain open for prosecution. Non-elected claims have not been rejoined at this time.

1. The indicated allowability of claim 4 is withdrawn in view of the newly discovered reference, U.S. Patent No. 3,860,673 to Lawrence. Rejections based on the newly cited reference follow.

#### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3 and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,860,673 to Lawrence.

The prior art of Lawrence discloses a composition comprising an elastomer, an organic polyisocyanate which has been at least partially trimerized and catalyst (claim 1). This composition is useful as an adhesive (col. 1, line 2). Preferred elastomers include natural rubber and styrene-butadiene rubber (col. 2, lines 53 and 54). Use of blends with other elastomers such

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as polyethylene and its copolymers is contemplated (col. 1, lines 57-60). In a particular embodiment, the polyisocyanate is comprised of a mixture of isocyanates (claim 7). In this case, the 2,4-TDI and 2,6-TDI isomers have different reactivities. The amount of polyisocyanate is used in quantities sufficient to provide from 1-10 wt % of free NCO groups based on the weight of elastomer A. This lies well within the 0.008 – 5 mole NCO / kg elastomer range recited in the present claim. There is mentioned use of zinc oxide or magnesium oxide as acid acceptor in the composition (col. 4, line 8). In addition, other materials including resins may be incorporated into the composition. Finally, the catalyst, a tertiary amine, while used to catalyze isocyanate trimerization, is also used to catalyze crosslinking reactions. Since the catalyst is, by definition, regenerated, it would remain in the composition to catalyze the secondary reaction. As such, the subject matter of the present claims is adequately disclosed in the prior art.

4. The following rejections, set forth in the previous office action, have been overcome by amendment:

(i) Claims 1, 2 and 5, rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,021,391 to Ijichi *et al.*

(ii) Claims 1-3 and 6, rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,760,135 to Korpman *et al.*

(iii) Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,932,558 to Kest *et al.*

(iv) Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 58-7471.

(v) Claims 1, 2 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,204,046 to Minatono *et al.*


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (703)306-0094. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (703)308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703)746-7064. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

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September 22, 2002

  
**D. R. WILSON**  
**PRIMARY EXAMINER**